

Applicants: Oliver Nickel  
Application No. 09/844,083  
Amendment in Response to Office Action dated September 10, 2004

REMARKS

Applicant respectfully requests reconsideration and allowance of this application in view of the following comments.

Claims 1-20 are pending. Applicant is grateful for the Examiner's withdrawal for his previous objections and rejections in view of Applicant's paper filed on August 11, 2004.

Rejections under 35 U.S.C. 103

The Examiner rejected claims 1-20 under 35 U.S.C. 103(a) as being obvious over Patel et al. (U.S. Patent No. 5,385,783) in view of Sakumoto et al. (U.S. Patent No. 5,683,806) further in view of Leeuwenburgh (U.S. Patent No. 5,935,669). The Examiner found Patel to generally teach a high temperature resistant masking tape, wherein the tape is comprised of conventional crepe paper. The Examiner concedes Patel does not teach a film. According to the Examiner, Sakumoto teaches an adhesive tape comprising a heat-resistant base film and a protective adhesive layer laminated on at least one surface of the base film. But he concedes neither Patel nor Sakumoto teach a masking film which is folded or which extends beyond the edge of the masking paper. The Examiner found Leeuwenburgh to teach a cover sheet folded with extending folds protruding beyond the other folding layers, an adhesive tape being fastened along a longitudinal edge portion where the folded portion is rolled. The Examiner ultimately found it would have been

obvious to combine the protective laminated adhesive layer of Sakumoto with the adhesive layer of Patel to obtain the instantly claimed invention. In addition, the Examiner found it would have been obvious to fold “the masking strip of Patel” leaving extended portions, because Leeuwenburgh teaches this to be a conventional practice in the art, wherein the extended portions can be used to adhere the strip to various surfaces.

At the outset, in making his obviousness rejection, the Examiner states that it would have been obvious to “fold the masking strip of Patel”. The term was not mentioned in his discussion of Patel. Therefore, it is not clear from the rejection what the Examiner is referring to, since this is the first recitation of the term “a masking strip”. For purposes of this rejection, it is assumed that the Examiner is referring to the masking tape of Patel.

Therefore, in response to the obviousness rejection, Applicant submits there must be some suggestion or motivation, either in the reference of knowledge generally available to a person skilled in the art to modify the teaching of the reference. *See MPEP §2143*. Moreover, all of the claim limitations must be taught or suggested by the prior art. *See MPEP §2143.03*. Applicant submits that the combination of Patel, Sakumoto and Leeuwenburgh are inadequate, as a matter of law, to make out a *prima facie* case of the obviousness of the present invention. Applicant respectfully submits that a person skilled in the art would not have been led to the present invention from the cited references. It is believed the Examiner has not addressed one of the claim elements in its

entirety, which is the “masking material, which is laminated in an edge region of the pressure-sensitive adhesive layer, said masking material being capable of adhering to paint and of absorbing paint”. In his rejection, the Examiner addresses the adhesive tape in Patel, but then states that Patel does not teach a film, which is folded or extends beyond the edges. As this relates to the claims, the “film” as alleged by the Examiner would most closely relate to the masking sheet as instantly claimed. However, the Examiner has not proposed any suggestion or teaching of the masking material. This is further substantiated by the Examiner’s rejection at the top of page 3 of the Office Action – after discussing both Patel and Sakumoto – where he states that “[n]either reference teaches the masking film being folded or the masking film extending beyond said second edge of the masking paper.” The Examiner then applies Leeuwenburgh to allegedly teach the folded nature of the masking sheet. Again, the Examiner does not suggest the masking material in any of the references. If the Examiner disagrees with the Applicant’s position, Applicant respectfully requests further clarification as to which claim element(s) is/are taught or suggested by Patel.

If the Examiner relied on any one or combination of Patel, Sakumoto and Leeuwenburgh to teach a masking material, then a closer examination of the references and the Examiner’s rejection would reveal that the Examiner might have relied upon Sakumoto to teach the instantly claimed masking material as evidenced by his argument regarding the adhesive layer starting at the bottom of page 3 of the Office Action. Therefore, assuming this is true, which Applicant does not concede, there is still no

suggestion or motivation for person skilled in the art to obtain the present invention, because none of the references suggest “a masking sheet, which is laminated onto said edge region of the pressure-sensitive adhesive layer, the masking sheet covering the masking material on a side thereof”. The mere fact that references can be combined or modified, which Applicant does not concede here, does not render the resulting combination obvious unless the prior art also suggests the desirability of the combination.

*See In re Mills*, 16 USPQ2d 1430 (Fed. Cir. 1990). Applicant points out that a person skilled in the art would not have been led to the present invention because Leeuwenburgh contains no suggestion of the cover sheet covering a masking material. Leeuwenburgh shows a cover sheet which is adhered to an adhesive tape, but its relationship to the instantly claimed structure cannot be ascertained, because there is no suggestion of the structural relationship of the masking material with that of the masking sheet.

Regarding the masking material, the instant specification at the last paragraph of page 3 discusses one problem which the present invention addresses, which is the selection of the masking material. The applicable portion of the paragraph recites in part:

The adsorptive material, especially woven material, nonwoven material or paper, is intended to absorb the heavier application of paint in the edge region of the painting and to adhere reliably also after oven drying, so that paint cannot fall onto the still soft, freshly painted surface.

Applicant points out that the masking material is selected so that it can, for example, both

absorb a heavy application of paint and adhere reliably to a surface after oven drying. If the Examiner is relying on Sakumoto for the teaching of a masking material, Applicant points out that Sakumoto is directed to overcoming the problems in the area of electronic parts such as resin-sealed-type semiconductor devices, and not in the area of painting. *See* Sakumoto, col. 1, lines 13-16; col. 2, lines 10-13. Consequently, whereas Sakumoto is concerned with the selection of materials related to electronic parts, the present invention solves a problem relating to the selection of a masking material for painting. Accordingly, it is clear that Sakumoto, in combination with Patel, are talking about something different than the problem which the present invention solves, wherein this problem is a problem of great practical significance affecting the customer's desire to purchase the product in the first place. Accordingly, because the combination of references do not teach or suggest to a person skilled in the art a masking tape which comprises the masking material as instantly claimed, claims 1-20 are not rendered *prima facie* obvious.

In view of the foregoing, Applicant submits that the Examiner would be fully justified to reconsider and to withdraw this rejection. An early notice that this rejection has been reconsidered and withdrawn is, therefore, earnestly solicited.

### Conclusion

Applicant believes that the foregoing constitutes a bona fide response to all outstanding objections and rejections.

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Applicant also believes that this application is in condition for immediate allowance. However, should any issue(s) of a minor nature remain, the Examiner is respectfully requested to telephone the undersigned at telephone number (212) 808-0700 so that the issue(s) might be promptly resolved.

Early and favorable action is earnestly solicited.

CONDITIONAL PETITION FOR EXTENSION OF TIME

If entry and consideration of the amendments above requires an extension of time, Applicant respectfully requests that this be considered a petition therefor. The Commissioner is authorized to charge any fee(s) due in this connection to Deposit Account No. 14-1263.

ADDITIONAL FEE

Please charge any insufficiency of fees, or credit any excess, to Deposit Account No. 14-1263.

Respectfully submitted,

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